

REMARKS

Upon entry of this Amendment, claims 1-24 will remain pending, with claims 1-4 and 17-24 withdrawn from consideration. Applicants thank the Examiner for withdrawing previous grounds of rejection (Office Action at p. 9).

I. Regarding the Non-Final Office Action

In the Office Action¹, the Examiner rejected claims 5-6 and 14-16 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,629,136 to Naidoo (“*Naidoo*”) in view of U.S. Patent No. 6,058,311 to Tsukagoshi (“*Tsukagoshi*”). The Examiner rejected claims 7-11 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo*, in view of *Tsukagoshi*, and in further view of U.S. Patent No. 6,330,598 to Beckwith, et al. (“*Beckwith*”). The Examiner also rejected claim 12 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo*, in view of *Tsukagoshi*, and in further view of U.S. Patent No. 6,636,489 to Fingerhut (“*Fingerhut*”). Finally, the Examiner rejected claim 13 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo*, in view of *Tsukagoshi*, and in further view of *Fingerhut* and *Beckwith*.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Applicants address the Examiner’s rejections in turn.

II. Regarding the amendment of the specification

Applicants amend the specification to improve form and grammar.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

III. Regarding the amendment of claims 5-16

Applicants amend claims 5-8 to more particularly define the invention. Support for these amendments may be found at, for example, pp. 17-20 and 24, particularly in the second paragraphs on p. 20 and 24 of Applicants' disclosure and in Figs. 1, 4A, 4B, 5A, and 5B.

Applicants amend claims 9-13 to improve form and grammar and not for reasons related to patentability.

Applicants amend claims 14-16 to more particularly define the invention. Support for these amendments may be found in the above noted sections and additionally at, for example, pp. 30-33 of Applicants' disclosure and in Figs. 10A, 10B, and 11.

III. Regarding the rejection of claims 5-6 and 14-16 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo* in view of *Tsukagoshi*

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 5-6 and 14-16.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Naidoo* nor *Tsukagoshi*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims.

Claim 5 recites, among other things:

a communication control unit [that] ... converts a user identifier of the mobile terminal in the service request sent by the mobile terminal to a temporary identifier; stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier.

Similarly, claim 14 recites, among other things:

a communication control unit [that] ... converts a user identifier of the mobile terminal in a service request sent by the mobile terminal to a temporary identifier; stores communication control information including a service request identifier, a service provider name, the temporary identifier, and a parameter; and sends service request information to one of said user identification service provider and said user non-identification service provider based on a type of the service request, the service request information being the communication control information excluding the temporary identifier based on the type of the service request.

The Examiner concedes that *Naidoo* “does not explicitly teach a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the user; wherein said communication control unit converts a user identifier of the mobile terminal in a service request ... sent by the mobile terminal to a temporary identifier” (Office Action at p. 3). In addition to this deficiency, *Naidoo* does not teach or suggest at least storing “communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter; and sends the service request information to said service provider, the service request information being the communication control information without the temporary identifier,” as required by independent claims 5 and 14.

The Examiner, however, asserts “*Tsukagoshi* teaches a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the user(col.2, lines 1-15); wherein said communication control unit converts a user identifier of the mobile terminal in a service request ... sent by the mobile terminal to a temporary identifier(col.1, line 67-col.2, line3)” (Office Action at p. 3). Even assuming the Examiner’s assertion is true, *Tsukagoshi* is silent at least on the claim elements reciting storing “communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter, and sends service request information to said service provider, the service request information being the communication control information without the temporary identifier,” as required by independent claims 5 and 14. *Tsukagoshi* teaches “[t]he first home memory station receives data of the mobile station including the unique identifier from a second home memory station of the home network to link the data of the mobile station with the second temporary identifier The first home memory station transmits the second temporary identifier back to the mobile station to communicate ...” (Office Action at p. 3 citing *Tsukagoshi*, col. 2, lines 3-14). That is, the system of *Tsukagoshi* communicates by “receiv[ing] ... the unique identifier [and] transmit[ing] the second temporary identifier.” However, this does not constitute a teaching or suggestion of at least transmitting “service request information being the communication control information excluding the temporary identifier,” as recited in independent claims 5 and 14 (emphasis added).

Because *Naidoo*, as conceded by the Examiner, and *Tsukagoshi*, taken alone or in combination, fail to teach or suggest each and every claim element, a *prima facie* case of obviousness has not been established. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow independent claims 5 and 14.

Dependent claims 6, 15, and 16 are allowable at least due to their dependence on allowable claims 5 and 14 and for additional distinctions recited therein. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claims 6, 15, and 16.

IV. Regarding the rejection of claims 7-11 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo* in view of *Tsukagoshi*, and in further view of *Beckwith*

Claims 7-11 depend from claim 5 and therefore include all the elements recited therein. As set forth above, neither *Naidoo* nor *Tsukagoshi*, taken alone or in combination, teach or suggest at least:

a communication control unit [that] ... converts a user identifier of the mobile terminal in the service request sent by the mobile terminal to a temporary identifier, stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter, and sends service request information to said service provider, the service request information being the communication control information without the temporary identifier,

as recited in independent claim 5.

Beckwith fails to cure the deficiencies of *Naidoo* and *Tsukagoshi*. *Beckwith* is merely relied upon for allegedly teaching a service provider name (Office Action at p. 5). *Beckwith* does not teach or suggest at least:

a communication control unit [that] ... converts a user identifier of the mobile terminal in the service request sent by the mobile terminal to a temporary identifier, stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter, and sends service request information to said service provider, the service request information being the communication control information without the temporary identifier

as recited in independent claim 5 and required by claims 7-11. Furthermore, claims 7-11 contain additional distinctions recited therein.

Because *Naidoo*, *Tsukagoshi*, and *Beckwith*, taken alone or in combination, fail to teach or suggest each and every claim element, a *prima facie* case of obviousness has not been established for dependent claims 7-11. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claims 7-11.

V. Regarding the rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo* in view of *Tsukagoshi*, and in further view of *Fingerhut*

Claim 12 depends from independent claim 5 and therefore includes all the elements recited therein. As set forth above, neither *Naidoo* nor *Tsukagoshi*, taken alone or in combination, teach or suggest at least:

a communication control unit [that] ... converts a user identifier of the mobile terminal in the service request sent by the mobile terminal to a temporary identifier, stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter, and sends service request information to said service provider, the service request information being the communication control information without the temporary identifier,

as recited in independent claim 5.

Fingerhut fails to cure the deficiencies of *Naidoo* and *Tsukagoshi*. The Examiner asserts “*Fingerhut* teaches a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service

request information sent by the mobile terminal through said communication network” (Office Action at p. 7). However, the relied upon portion of *Fingerhut*, col. 1, lines 41-64, is background information teaching away from the Examiner’s assertion. *Fingerhut* discloses “[t]he manual assignment of a unique address at the time of manufacture increases the cost of manufacturing.” Even assuming the Examiner’s assertion regarding the teachings of *Fingerhut* is true, neither the cited portion of *Fingerhut* or any other portion constitutes a teaching or suggestion of:

a communication control unit [that] ... converts a user identifier of the mobile terminal in the service request sent by the mobile terminal to a temporary identifier, stores communication control information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter, and sends service request information to said service provider, the service request information being the communication control information without the temporary identifier

as recited in independent claim 5 and required by claim 12. Furthermore, claim 12 contains additional distinctions recited therein.

Because *Naidoo*, *Tsukagoshi*, and *Fingerhut*, taken alone or in combination, fail to teach or suggest each and every claim element, a *prima facie* case of obviousness has not been established for dependent claim 12. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claim 12.

VI. Regarding the rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over *Naidoo* in view of *Tsukagoshi*, and in further view of *Fingerhut* and *Beckwith*

Claim 13 depends from independent claim 5 and therefore includes all the elements recited therein. As set forth above, *Naidoo*, *Tsukagoshi*, *Fingerhut*, and *Beckwith*, taken alone or in combination, fail to teach or suggest at least a communication control unit that

converts a user identifier of the mobile terminal in the service request sent by the mobile terminal to a temporary identifier, stores communication control

information including a service request identifier, a service provider name, the location information, the temporary identifier, and a parameter, and sends service request information to said service provider, the service request information being the communication control information without the temporary identifier,

as recited by independent claim 5 and required by claim 13. Furthermore, claim 13 contains additional distinctions recited therein.

Because *Naidioo*, *Tsukagoshi*, *Fingerhut*, and *Beckwith*, taken alone or in combination, fail to teach or suggest each and every claim element, a *prima facie* case of obviousness has not been established for dependent claim 13. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claim 13.

VII. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 11, 2005

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